

### **REMARKS**

In the Office Action, claims 1-2, 5-14, 23-24, 26-28, 41-53, and 55-58 were rejected under 35 U.S.C. § 103 in view of various cited references. By the present response, claims 1, 23, 41, 46 and 51 have been amended. Upon entry of the amendments, claims 1-2, 5-14, 23-24, 26-28, 41-53 and 55-58 still remain pending. Applicants respectfully request reconsideration of the present application in view of the remarks below.

### **Interview Summary**

Applicants thank the Examiner for his participation in telephonic interviews with the undersigned representative on June 3, 2005 and June 6, 2005. These interviews did not concern the substantive rejections made by the Examiner. In these interviews, Applicants discussed this response to the Final Office Action mailed on April 11, 2005, in light of the fact that the amendments made by Applicants to the independent claims add subject matter found allowable by the Board of Patent Appeals and Interferences in connection with the parent patent application, Serial No. 09/476,708, now allowed by the Examiner. The Examiner granted Applicants permission to file this response.

### **Legal Precedent**

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

**Rejections under 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 1-2, 5-14, 23-24, 26-28, 41-53, and 55-58 under 35 U.S.C. § 103(a) as being unpatentable over various cited references and assertions. Specifically, claims 1, 5, 8, 10, 11, 14, 51 and 52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,891,035 to Wood et al. ("Wood") in view of U.S. Pat. No. 5,260,999 to Wyman ("Wyman") and the Examiner's assertions relating to the duplication of known parts. Claims 9, 12, 23, 24, 26, 41-43, 53, 55 and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Wyman and Official Notice. Claims 7, 44 and 45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Wyman, U.S. Pat. No. 5,852,812 to Reeder ("Reeder"), and Official Notice. Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Wyman, Official Notice and U.S. Pat. No. 6,504,571 to Narayanaswami et al. ("Narayanaswami"). Claim 46 was rejected as being unpatentable over Wood in view of Wyman and U.S. Pat. No. 6,343,124 to Munoz ("Munoz"). Claim 27, 28, 47, 57 and 58 were rejected as being unpatentable over Wood in view of Wyman, Munoz, and Official Notice. Claims 48, 49 and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Wyman, Official Notice, Munoz and Admitted Prior Art. Applicants respectfully traverse each of the rejections.

The above rejections are essentially identical to those made by the Examiner in the Non-final Office Action mailed on November 3, 2004. The rejected claims are believed to be allowable for the same reasons mentioned in Applicants' response, mailed on February 3, 2005, to the Non-final Office Action. Applicants hereby incorporate into this response all arguments raised in Applicants' previous response, and request that all rejections be withdrawn.

*The cited references fail to disclose use of an "exemplary image."*

Independent claims 1, 23, 41, 46 and 51 have all been amended to recite: "user viewable indicia includ[ing] an exemplary image...." Nowhere in any of the references cited by the Examiner (Wood, Wyman, Reeder, Narayanaswami, and Munoz) is there any reference to "user viewable indicia includ[ing] an exemplary image," as in claims 1, 23, 41, 46, and 51. For at least this reason, the cited references do not disclose or suggest each and every element set forth in independent claims 1, 23, 41, 46, and 51. Therefore, none of claims 1, 23, 41, 46, and 51 can be rendered obvious by any combination of Wood, Wyman, Reeder, Narayanaswami, and Munoz, and Applicants respectfully request allowance of these claims.

Furthermore, claims 1, 23, 41, 46, and 51 are independent claims from which the remainder of the claims rejected the Examiner depend. Specifically, claims 2 and 5-14 are dependent from claim 1; claims 24 and 26-28 are dependent from claim 23; claims 42-45 are dependent from claim 41; claims 47-50 are dependent from claim 46; and claims 52-53 and 55-58 are dependent from claim 51. As noted above, independent claims 1, 23, 41, 46, and 51 are allowable because no combination of Wood, Wyman, Reeder, Narayanaswami, and Munoz discloses or suggests each element of the independent claims. As a result, dependent claims 2, 5-14, 24, 26-28, 42-45, 47-50, 52-53, and 55-58 are allowable on the basis of their dependency from a respective allowable independent claim, as well as for the subject matter recited in these dependent claims. Accordingly, Applicants respectfully request withdrawal of

the Examiner's rejections and allowance of claims 2, 5-14, 24, 26-28, 42-45, 47-50, 52-53, and 55-58.

**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: 6/7/2005

Py  
Patrick S. Yoder  
Reg. No. 37,479  
FLETCHER YODER  
P.O. Box 692289  
Houston, TX 77269-2289  
(281) 970-4545